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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/137,503	08/20/1998	PETER A. GRAEF	WEYC111558	2949

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/137,503

Applicant(s)

GRAEF ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6-23,26,31,32 and 75-77 is/are pending in the application.
- 4a) Of the above claim(s) 14,15,21-23,26 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6-13,16-20,32 and 75-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20. 6) ☐ Other: _____

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Applicant's response of 10-15-02 has been entered. The examiner will address applicant's remarks at the end of this office action.

Newly amended claims 14 and 15 are now directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The applicant has amended these claims so that they do not recite the elected species that applicant elected in the paper of 8/23/01. The member of the markush grouping that was elected by applicant has been canceled from claim 14; therefore the claim is not directed to the elected species and has been withdrawn from consideration by the examiner and is now a non-elected claim. With respect to claim 15, none of the originally presented claims recited that the first stratum "further comprises" natural fibers as now claimed, and the election by applicant on 8/23/01 made not mention at all of the elected species having a first stratum made of multiple types of fibers in addition to a binder. Applicant's election states the elected species for the fibers of the first stratum was "specifically polyethylene terephthalate fibers". The addition of natural fibers will necessarily affect the way the composite works/functions and is considered a distinct species for this reason. Claims 14 and 15 are non-elected based on applicant's election of 8/23/01.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16-18,77, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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With respect to claims 16-18,77, applicant has recited "wherein at least one binder comprises....". What exactly is the "at least one binder"? Is this one of the previously recited binders or is this at least one binder in addition to the binders recited in claim 1? This is not clear the way the claim is written and renders the claim indefinite. It is not clear what binder is being referred to by the language "at least one binder".

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1,6,7,9-12,16,18,75-77, are rejected under 35 U.S.C. 103(a) as being unpatentable over Pieniak (4723954) in view of Graef et al. (5225047).

With respect to claims 1,6,7,75-77, Pieniak discloses a 1st stratum 32 and 2nd stratum 30. The 1st stratum has synthetic fibers (see col. 2, lines 57-60) and a binder

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(see column 3, lines 4-17). The 1st stratum is made from the claimed type of fiber (see polyester in column 2, lines 57-60). The 2nd stratum is made from wood pulp fibers and does have a binder. The term binder is being interpreted as it has been defined by the specification on page 13. The disclosure of air laying the 2nd stratum with compression or vacuum being applied acts to bind the layer together and is therefore considered a binder. This interpretation is commensurate with the definition provided by applicant in the specification on page 13. The fibers of each stratum are substantially commingled as claimed. See the figures, especially figure 2. Pieniak does not disclose that the fibers of the 2nd stratum are crosslinked cellulose fibers. Pieniak discloses the fibers of the 2nd stratum as being wood pulp. Graef discloses that crosslinked cellulose fibers provide advantages in absorbent articles such as being stiffer and tending to hold retained liquid better under compressive forces as compared to untreated fibers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the 2nd stratum of Pieniak with crosslinked cellulose fibers as disclosed by Graef for the reasons set forth by Graef (i.e. being stiffer and tending to hold retained liquid better under compressive forces as compared to untreated fibers). With respect to claim 75, the limitation of "foam-formed" has been considered but is a product by process limitation and only the end structure of the article will be given patentable weight, not the manner in which the article was made. The resulting end structure is found in Pieniak.

With respect to claims 9,11, see column 2, lines 64-66, which satisfies the claimed range.

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With respect to claims 10,12, Pieniak does not disclose what the density of the 2nd stratum is. The 2nd stratum of Pieniak does have a density, Pieniak is just silent as to what the value is. Optimization of the density through routine experimentation would have been obvious to one of ordinary skill in the art at the time the invention was made since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With respect to claim 16, the binder of the 1st stratum is a fibrous binding material because it binds together fibers (a fibrous material).

With respect to claims 18,77, Pieniak discloses one of the binders as being a wet strength agent. The binder disclosed for the 1st stratum in col. 3, lines 4-17 satisfy the claimed limitation.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pieniak in view of Graef et al. and further in view of Anderson (4223677). Pieniak in view of Graef disclose the invention substantially as claimed. Not disclosed is that the pore size of the 1st stratum is greater than the pore size of the 2nd stratum. Anderson discloses an absorbent article that utilizes a pore size difference between layers of an absorbent to direct urine to the lower layer. Anderson discloses that a capillary gradient is created when the smaller pore sizes are in a lower layer and where the upper layer has a larger pore size. This drives the fluid to the lower layer as well as giving the lower layer more ability to hold onto the liquid already absorbed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Pieniak with a 1st

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stratum with a larger pore size than the pore size of the 2nd stratum (as disclosed by Anderson) so that a capillary gradient is created for the reasons disclosed by Anderson.

6. Claims 1,6,7,9-13,16,18-20,75,76, are rejected under 35 U.S.C. 103(a) as being unpatentable over Butterworth (4129132) in view of Graef et al. (5225047).

With respect to claims 1,6,7, Butterworth discloses a 1st stratum (the first fibrous layer) and a 2nd stratum (the 2nd fibrous layer). The 1st stratum is disclosed as having synthetic fibers (see column 6, lines 1-14). The binder of the 1st stratum is disclosed in column 5, lines 59-68, column 6, line 62 to column 7, line 1, column 4, lines 34-39, and in column 11, lines 20-26. The 2nd stratum made from synthetic wood pulp fibers and the binder of the 2nd stratum is disclosed in column 4, lines 34-39, column 7, lines 3-11, and in column 11, lines 20-26. For the limitation of the substantially commingled fibers see column 3, lines 1-13, column 3, lines 31-38, and column 8, lines 10-18. Butterworth does not disclose that the synthetic wood pulp fibers (cellulosic) are crosslinked. Graef discloses that crosslinked cellulose fibers provide advantages in absorbent articles such as being stiffer and tending to hold retained liquid better under compressive forces. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the 2nd stratum of Butterworth with crosslinked cellulose fibers as disclosed by Graef for the reasons set forth by Graef i.e. (being stiffer and tending to hold retained liquid better under compressive forces).

With respect to claims 9-12, see column 4, lines 50-53 where the claimed limitations are shown.

With respect to claim 13 see column 6, line 5. Polyester is the same as what has been claimed.

With respect to claim 16, the binder of the 1st stratum is a fibrous binding material because it binds together fibers (a fibrous material).

With respect to claim 18, as best understood by the examiner due to the 112 2nd paragraph problem, Butterworth discloses the claimed limitation. Butterworth discloses a latex binder for either the 1st or 2nd stratum. This is considered to be a wet strength agent. The latex binder has strength when wet.

With respect to claim 19, see column 4, lines 45-49.

With respect to claim 20, Butterworth discloses the claimed limitation. This is because claiming a denier without also claiming the material the fiber is made from means nothing. Denier is a fineness of a fiber based on 1 gram of the fiber drawn to a certain length. From this it is clear that the fineness can only be determined if the material is also claimed.

With respect to claim 75, Butterworth discloses a 1st stratum (the first fibrous layer) and a 2nd stratum (the 2nd fibrous layer). The 1st stratum is disclosed as having synthetic fibers (see column 6, lines 1-14). The binder of the 1st stratum is disclosed in column 5, lines 59-68, column 6, line 62 to column 7, line 1, column 4, lines 34-39, and in column 11, lines 20-26. The 2nd stratum being made from synthetic wood pulp fibers and the binder of the 2nd stratum is disclosed in column 4, lines 34-39, column 7, lines 3-11, and in column 11, lines 20-26. For the limitation of the substantially commingled fibers see column 3, lines 1-13, column 3, lines 31-38, and column 8, lines 10-18.

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Butterworth does not disclose that the synthetic wood pulp fibers (cellulosic) are crosslinked. Graef discloses that crosslinked cellulose fibers provide advantages in absorbent articles such as being stiffer and tending to hold retained liquid better under compressive forces. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the 2nd stratum of Butterworth with crosslinked cellulose fibers as disclosed by Graef for the reasons set forth by Graef (i.e. being stiffer and tending to hold retained liquid better under compressive forces). The limitation of "foam-formed" has been considered but is a product by process limitation and only the end structure of the article will be given patentable weight, not the manner in which the article was made. The resulting end structure is found in Butterworth.

With respect to claim 76, see column 6, line 5. Polyester is the same as what has been claimed.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Butterworth in view of Graef et al. and further in view of Anderson (4223677). Butterworth in view of Graef disclose the invention substantially as claimed. Not disclosed is the pore size difference recited in claim 8. Anderson discloses an absorbent article that utilizes a pore size difference between layers of an absorbent to direct urine to the lower layer. Anderson discloses that a capillary gradient is created when the smaller pore sizes are in a lower layer and where the upper layer has a larger pore size. This drives the fluid to the lower layer as well as giving the lower layer more ability to hold onto the liquid already absorbed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Butterworth with a

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1st stratum with a larger pore size than the pore size of the 2nd stratum (as disclosed by Anderson) so that a capillary gradient is created for the reasons disclosed by Anderson.

Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1,6-20,26, are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-23,25-32 of copending Application No. 09/620947.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,6-20,24,25,32,33,62-77 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the pending claims of copending Application No. 09/620953, 09/624263, 09/621167, 09/624262, 09/326213, 09/624081, 09/620947, 09/620950. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope and a terminal disclaimer is required to maintain common ownership of claims of overlapping scope. Some of the claims simply fail to recite elements of the claims of the above mentioned pending applications. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Applicant's arguments filed 10-15-02 have been fully considered but they are not persuasive.

With respect to applicant's counsel calling the attention of the examiner to an alleged "protracted prosecution", the comments are noted. The examiner takes notice that if a person were to read the prosecution history, they would be apprised of what happened and when ; therefore any further comments from the examiner are not necessary and are not considered to be relevant to the issues pending in this office action.

With respect to the implication by applicant's counsel that the examiner has not yet "completed examination of the application", the examiner can only stress to applicant's counsel and the inventors themselves that the office action of 4/22/02 was a

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complete and thorough examination of the application. To indicate otherwise is an allegation that the examiner is not doing his job, which is not the case.

Applicant's arguments with respect to most of the issues have been considered but are moot in view of the new ground(s) of rejection.

With respect to the traversal of the provisional 101 statutory double patenting rejection in view of 09/620,947 the argument is non-persuasive. The product by process limitations of "wet laid" does not define any end structure to the article that is not also present in the pending claims of the instant application; therefore, the scope of the claims is the same. The examiner is of the opinion that one set of claims cannot be infringed without also infringing the other set of claims, which is the test to see if there is a 101 statutory double patenting rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703-308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



DENNIS RUHL
PRIMARY EXAMINER